

222.94213.CON2

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Samuel A. BARTS Art Unit: 1621

In re: Application of: Ronald B. MILLER, et al.

Serial No.: 09/800,204

Filed: March 6, 2001

For: **CONTROLLED RELEASE
TRAMADOL**

#8
11/1/02
J. Miller

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

October 23, 2002

Sir:

In accordance with the provisions of 37 C.F.R. § 1.97, Applicants hereby make of record the documents attached herewith for consideration by the Examiner in connection with the examination of the above-identified patent application.

This Information Disclosure Statement is filed under 37 C.F.R. § 1.97 (c), before the mailing date of any Final Office Action on the merits, a Notice of Allowance, or an action that otherwise closes prosecution in the application.

Attachments A, C and D are Information Disclosure Statements which discuss references relating to the Opposition and Litigation based on corresponding European Patent No. EP 0 624 366. These Information Disclosure Statements and the references listed therein have been previously submitted during the prosecution of the parent case, U.S. Serial No. 08/449,772, now U.S. Patent No. 6,326,027.

10/30/2002 NMDHAMM1 00000089 09800204

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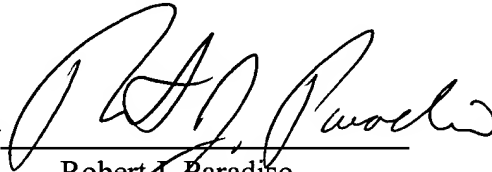
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Moreover, Attachment B is a Response that was filed in the above-mentioned parent case, which further discusses the Opposition proceedings based on the '366 European Patent. The references discussed therein were also previously submitted during the prosecution of the parent case. It is respectfully requested that Attachments A, B, C and D be considered and made of record.

A check in the amount of \$180.00 is enclosed for the fee due under 37 C.F.R. § 1.17(p). If it is determined that any additional fees are due or that any fee has been overpaid, the Commissioner for Patents is hereby authorized to charge said fee or credit any overpayment to Deposit Account No. 50-0552.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By 
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ATTACHMENT A

222.94213.DIV

UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

OCT 31 2002

TECH CENTER 1600/2900

Re: Application of: Ronald B. MILLER, et al.
Serial No.: 08/449,772
Filed: May 24, 1995
For: CONTROLLED RELEASE FORMULATION

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner of Patents
Washington, D.C. 20231

July 17, 1997

Sir:

In accordance with 37 C.F.R. paragraphs 1.97-1.99, copies of the references listed on the attached form PTO-1449 are enclosed herewith.

The Examiner's attention is drawn to the fact that a corresponding European Patent EP 0 624 366 B1 has now been opposed by seven (7) opposers. The granted claims of EP 0 624 366 B1 are directed to compositions and are different than the pending claims in the present application. The corresponding Chilean Patent Application 667-94 has also been opposed by one of the opposers of the European patent. The documents cited in the Chilean Opposition have also been cited in the European Opposition.

I hereby certify that this correspondence and/or fee is being deposited with the United States Postal Service as first class mail in an envelope addressed to "Assistant Commissioner for Patents, Washington, D.C. 20231" on July 22, 1997.

STEINBERG, RASKIN & DAVIDSON, P.C.

BY: Alan Meyer

In order to ensure compliance with disclosure requirements under Rule 56, Applicants submit herewith a PTO-1449 form which lists each and every reference which has been cited in the above-mentioned EP Opposition. In addition, submitted herewith are copies of the Opposition papers (or English translations thereof where appropriate) submitted by each opponent. These copies include submissions by Arzneimittelwerk Dresden GmbH, Bioglan Laboratories Ltd., Gruenenthal GmbH, Krewel Meuselbach GmbH, Hexal AG, Lannacher Heilmittel GmbH, and Nycomed Danmark A/S. For the Examiners convenience, Applicants have separately enclosed Appendix A, which correlates the references cited by the opposers. Certain of these references have already been cited by Applicants in a previous Information Disclosure Statement and have already been considered and made of record by the Examiner. However, for the sake of completeness, Applicants have once again provided copies of the previously cited documents.

The Examiner's particular attention is drawn to the fact that the U.S. Patent corresponding to EP 147 780, cited and relied upon by several opponents, has previously made of record in both the present application and in the parent application (U.S. Patent No. 5,591,452).

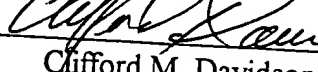
The Examiner's attention is also directed to the page 8 of the twelve page PTO-1449 form that was submitted with Applicants' Information Disclosure Statement of August 15, 1994. On that page, the Examiner indicated that certain references were not considered. Applicants have once again recited these references on the present PTO-1449 form, and have resubmitted copies of these references, along with English translations where appropriate.

Applicants have also obtained English translations of certain non-English language journal articles that were previously cited in the Information Disclosure Statement mailed October 20, 1995. Copies of both the journal articles and their English translations are submitted herewith for the Examiner's further consideration.

The undersigned also respectfully directs the Examiner's attention Assignee's co-pending patent applications U.S. Serial Nos. 08/774,229; 08/404,293; 08/607,852; 08/343,630; 08/607,851; and 08/843,571. Abandoned application 08/269,208 is also brought to the Examiner's attention.

It is respectfully requested that all of the references cited herein be made of record in the instant application. A check in the amount of \$230.00 is enclosed to cover the cost of the fee for entering this Information Disclosure Statement.

Respectfully submitted,
STEINBERG, RASKIN & DAVIDSON, P.C.

By 
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